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OFFICE OF PETITIONS

Sughrue Mion-ABBOTT LABS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

In re Application of	:	
Gilson et al.	:	DECISION ON APPLICATION
Application No. 10/058,828	:	FOR PATENT TERM ADJUSTMENT
Filed: January 30, 2002	:	
Attorney Docket No. A8937	:	

This is a decision responding to the papers August 25, 2010, which are being treated as a petition under 37 C.F.R. § 1.705(b). Applicants request the initial determination of patent term adjustment be corrected from two hundred thirty (230) days to six hundred seventy-three (673) days.

The application for patent term adjustment is **granted to the extent indicated herein**.

The Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) ("Determination") on May 26, 2010, advising Applicants of a patent term adjustment to date of 230 days. The instant petition was timely filed with the issue fee on August 25, 2010.

Applicants state the Office's PAIR system indicates the initial patent term adjustment is 673 days, which is the 230 days set forth on the Determination increased by 443 days of Office delay under 37 C.F.R. § 1.703(c)(1). Applicants assert the patent term adjustment set forth in PAIR is correct.

The Office has reviewed the record and determined the correct initial patent term adjustment is 933 days. As a result, the Office has updated the Office's PALM screen (and PAIR) to reflect the correct patent term adjustment at the time of the mailing of the Notice of Allowance is 933 days. A copy of the updated PALM screen showing the correct determination is enclosed.

Delay Under 37 C.F.R. § 1.703(c)(1) ("C Delay")

As of the date the petition was filed, PAIR indicated the period of C Delay is 443 days. Applicants agree with the 443-day determination.

A review of the record indicates the correct period of C Delay is 444 days.

Pursuant to 37 C.F.R. § 1.703(c)(1), the period of C Delay includes:

The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application.

The Office declared an interference on January 30, 2008.

The Office issued a decision on the interference on April 17, 2009.

The number of days beginning January 30, 2008, the date the interference was declared, and ending on April 17, 2009, the date the Office issued the decision, is 444 days. In other words, the period of C Delay is 444 days.

Delay Under 37 C.F.R. § 1.703(a) ("A Delay")

As of the date the petition was filed, PAIR indicated the period of A Delay consisted solely of 527 days of delay under 37 C.F.R. § 1.703(a)(1). Applicants agree the period of A Delay is 527 days.

A review of the record indicates the correct total period of A Delay is 1,137 days.

Applicants filed a reply to a prior Office action on January 30, 2006.

The Office issued a communication suspending prosecution on April 2, 2007.

The Office declared an interference on January 30, 2008.

Pursuant to 37 C.F.R. § 1.703(a)(2), the period of A Delay includes:

The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

The number of days beginning May 31, 2006, the day after the date four months and Applicants filed the January 30, 2006 reply, and ending January 30, 2008, the date the Office declared an interference is 610 days. In other words, the period of A Delay includes 610 days of delay under 37 C.F.R. § 1.703(a)(2).

The total period of A Delay is 1,137 days, which is the sum of 527 days of delay under 37 C.F.R. § 1.703(a)(1) and 610 days of delay under 37 C.F.R. § 1.703(a)(2).

Overlap Between the Period of A Delay and the Period of C Delay

The 610-day period of delay under 37 C.F.R. § 1.703(a)(2) includes January 30, 2008, the date the Office declared an interference. The 444-day period of C Delay also includes January 30, 2008. Therefore, the periods of A Delay and C Delay overlap by one day.

Delay Under 37 C.F.R. § 1.704 (“Applicant Delay”)

As of the date the petition was filed, PAIR indicated the total period of Applicant Delay is 297 days. Applicants agree the total period of Applicant Delay is 297 days.

The 297-day period consists of:

1. A 123-day period of delay under 37 C.F.R. § 1.704(b),
2. A 90-day period of delay under 37 C.F.R. § 1.704(b),
3. A 7-day period of delay under 37 C.F.R. § 1.704(b), and
4. A 77-day period of delay under 37 C.F.R. § 1.704(c)(8).

A review of the record indicates the correct period of Applicant Delay is 647 days.

37 C.F.R. § 1.704(b) provides for a reduction when a party takes more than 3 months to respond to any notice or action by the Office making any rejection, objection, argument or other request. Specifically, 37 C.F.R. § 1.704(b) states,

[A]n applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

The Office issued an action on September 21, 2005. A reply to the action was not filed until January 30, 2006. The reply was filed more than three months after the Office issued the action. Therefore, a reduction in patent term adjustment is warranted under 37 C.F.R. § 1.704(b).

The number of days beginning December 22, 2005, the day after the date three months after the Office mailed the September 21, 2005 action, and ending on January 30, 2006, the date Applicants filed a reply, is 40 days. Therefore, the total period of Applicant Delay includes a 40-day period of delay under 37 C.F.R. § 1.704(b).

Pursuant to 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

Applicants filed a reply to an Office action on January 30, 2006. Applicants subsequently filed an information disclosure statement ("IDS") on December 6, 2006. The IDS was not accompanied by a statement under 37 C.F.R. § 1.704(d) and the record fails to indicate the examiner expressly requested the IDS. Therefore, a reduction in patent term adjustment is warranted under 37 C.F.R. § 1.704(c)(8).

The number of days beginning January 31, 2006, the day after the date the reply was filed, and ending on December 6, 2006, the date the IDS was filed, is 310 days. Therefore, the total period of Applicant Delay includes a 310-day period of delay under 37 C.F.R. § 1.704(c)(8).

In view of the prior discussion, the correct total period of Applicant Delay is 647 days, which consists of:

1. A 123-day period of delay under 37 C.F.R. § 1.704(b),
2. A 90-day period of delay under 37 C.F.R. § 1.704(b),
3. A 7-day period of delay under 37 C.F.R. § 1.704(b),
4. A 77-day period of delay under 37 C.F.R. § 1.704(c)(8),
5. A 40-day period of delay under 37 C.F.R. § 1.704(b), and
6. A 310-day period of delay under 37 C.F.R. § 1.704(c)(8).

Conclusion

The correct total period of A Delay is 1,137 days.

The correct period of C Delay is 444 days.

The periods of A Delay and C Delay overlap by one day.

The correct total period of Applicant Delay is 647 days.

The correct patent term adjustment as of the date the Office issued the Notice of Allowance is 933 days, which is the sum of 1,137 days of A Delay and 444 days of C Delay reduced by one day of overlap between the periods of A Delay and C Delay and reduced by 647 days of Applicant Delay.

Submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. No additional fee is required.

Applicants are reminded that any delays by the Office pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b) and any applicant delays under 37 C.F.R. § 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'C. S. Brantley', is positioned above the printed name.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM screen



Patent Term Adjustments



PTA/PTE Information Patent Term Adjustment Patent Term Extension

Application Number*: 10058828

Search

Explanation of PTA Calculation

Explanation of PTE Calculation

PTA Calculations for Application: 10058828

Application Filing Date	01/30/2002	Overlapping Days Between (A and B) or (A and C)	0
Issue Date of Patent		Non-Overlapping USPTO Delays	970
A Delays	527	PTO Manual Adjustment	260
B Delays	0	Applicant Delay (APPL)	297
C Delays	443	Total PTA (days)	933

* - Sorted Column

File Contents History

Action Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Duration PTO	Duration APPL	Parent Action Number
98	01/11/2011		P028	Adjustment of PTA Calculation by PTO	260	0	
88	05/26/2010		MN/=	Mail Notice of Allowance		0	
87	05/18/2010		IREV	Issue Revision Completed		0	
86	05/18/2010		N/=	Notice of Allowance Data Verification Completed		0	
85	05/18/2010		DVER	Document Verification		0	
84	05/18/2010		CNTA	Notice of Allowability		0	
70	04/06/2010		IDTC	Interference dispatch to TC		0	
69	02/17/2010		INHY	case Inherited		0	
66	06/15/2009		CADB	Correspondence Address Change		0	
65	04/20/2009		MID/F	Mail Interference Decision - Favorable		0	
64	04/17/2009	01/30/2008	ID/F	Interference Decision on Priority - Favorable	443	62	
63	07/09/2008		CADB	Correspondence Address Change		0	
62	01/30/2008		I.D.	Declaration of Interference		0	
60	10/09/2007		DOCK	Case Docketed to Examiner in GAU		0	
59	07/08/2007		FWDX	Date Forwarded to Examiner		0	
58	07/08/2007		EOSP	to Close the A/R Record and Reset the Status for Expired Suspensions.		0	
57	05/21/2007		LET.	Miscellaneous Incoming Letter		0	
56	04/02/2007		MLSP	Mail Letter of Suspension		0	
55	04/02/2007		LSP	Letter of Suspension - Examiner Initiated		0	
54	04/02/2007		CTID	Interference Initial Memo Disposal		0	
51.7	12/08/2006		M844	Information Disclosure Statement (IDS) Filed		0	
78	12/06/2006		IDSC	Information Disclosure Statement considered		0	
50	12/06/2006		RCAP	Reference capture on IDS		0	
49.7	12/06/2006		M844	Information Disclosure Statement (IDS) Filed		0	
49	12/06/2006		WIDS	Information Disclosure Statement (IDS) Filed		0	
80	11/13/2006		IDSC	Information Disclosure Statement considered		0	
53	11/13/2006		RCAP	Reference capture on IDS		0	
52.7	11/13/2006		M844	Information Disclosure Statement (IDS) Filed		0	
52	11/13/2006		WIDS	Information Disclosure Statement (IDS) Filed		0	
48	08/25/2006		C.AD	Correspondence Address Change		0	
47	08/25/2006		PA..	Change in Power of Attorney (May Include Associate POA)		0	
46	08/14/2006		MEXIN	Mail Examiner Interview Summary (PTOL - 413)		0	
45	08/14/2006		MEXIN	Mail Examiner Interview Summary (PTOL - 413)		0	
44	07/26/2006		EXIN	Examiner Interview Summary Record (PTOL - 413)		0	
43	07/26/2006		EXIN	Examiner Interview Summary Record (PTOL - 413)		0	
42	01/30/2006		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		0	
41	01/30/2006		XT/G	Request for Extension of Time - Granted		0	
40	12/19/2005		EXIN	Examiner Interview Summary Record (PTOL - 413)		0	
36	09/23/2005		FWDX	Date Forwarded to Examiner		0	
39	09/21/2005		MCTNF	Mail Non-Final Rejection		0	
38	09/19/2005		CTNF	Non-Final Rejection		0	
37	09/14/2005		LET.	Miscellaneous Incoming Letter		0	
35	09/14/2005	06/29/2005	SA..	Supplemental Response		27	26
29	09/01/2005		PA..	Change in Power of Attorney (May Include Associate POA)		0	
28	08/30/2005		EXIN	Examiner Interview Summary Record (PTOL - 413)		0	
27	07/08/2005		FWDX	Date Forwarded to Examiner		0	
26	06/29/2005	06/22/2005	A...	Response after Non-Final Action		2	23
25	06/29/2005		XT/G	Request for Extension of Time - Granted		0	
24	06/23/2005		EXIN	Examiner Interview Summary Record (PTOL - 413)		0	
23	03/22/2005		MCTNF	Mail Non-Final Rejection		0	
22	03/20/2005		CTNF	Non-Final Rejection		0	
21	03/16/2005		FWDX	Date Forwarded to Examiner		0	
20	03/07/2005	12/07/2004	ELC.	Response to Election / Restriction Filed		20	16
19	03/07/2005		XT/G	Request for Extension of Time - Granted		0	
18	09/21/2004		C.AD	Correspondence Address Change		0	

17	09/21/2004	PA..	Change in Power of Attorney (May Include Associate POA)		0
16	09/07/2004	03/30/2003 MCTRS	Mail Restriction Requirement	527	-1
15	09/07/2004	CTRS	Requirement for Restriction / Election		0
14	03/31/2004	TSSCOMP	IFW TSS Processing by Tech Center Complete		0
13	03/30/2004	DOCK	Case Docketed to Examiner in GAU		0
11	10/21/2003	A.PE	Preliminary Amendment		0
10	10/21/2003	A.PE	Preliminary Amendment		0
12.7	05/07/2003	M844	Information Disclosure Statement (IDS) Filed		0
12	05/07/2003	WIDS	Information Disclosure Statement (IDS) Filed		0
9	10/30/2002	TI1050	Transfer Inquiry to GAU		0
8	10/07/2002	OIPE	Application Dispatched from OIPE		0
7	10/04/2002	COMP	Application Is Now Complete		0
5	09/19/2002	05/19/2002 FLFEE	Payment of additional filing fee/Preexam	123	3
4	09/19/2002	OATHDECL	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant		0
3	02/19/2002	INCD	Notice Mailed--Application Incomplete--Filing Date Assigned		0
2	02/07/2002	SCAN	IFW Scan & PACR Auto Security Review		0
79	01/30/2002	IDSC	Information Disclosure Statement considered		0
51	01/30/2002	WIDS	Information Disclosure Statement (IDS) Filed		0
1	01/30/2002	IEXX	Initial Exam Team nn		0

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